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| 10/051,472 | 01/18/2002 | Barry P. Falvo | 10622-10US | 1450 |

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GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM, PA 19044

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| EXAMINER |
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WILDER, PETER C

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| ART UNIT | PAPER NUMBER |
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2623

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,472

Applicant(s)

FALVO ET AL.

Examiner

Peter C. Wilder

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/20/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,22,23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,22,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/18/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-19, 21, 24, and 30-51 are canceled.

Claims 20, 22 25, 27, 29 are amended.

Claims 23, 26 28 are original.

Specification

The modification to the specification received on 7/20/2006 regarding the addition of an explanation of element 305 in Figure 3 is accepted.

Response to Arguments

Applicant's arguments with respect to claims 20, 22, 23, and 25-29 have been considered but are not persuasive.

In response to applicant's argument that there is no suggestion to combine on page 7 of the remarks the references Ellis, Tyson, and Darbree, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The motivation to add

the reference Darbee to Ellis and Tyson comes from the teachings of Darbee in Column 2 lines 46-50.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 22, 25-27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. 2006/0031883 A1) in view of Tyson (Sams Teach Yourself Microsoft Outlook 2000 in 24 Hours) further in view of Darbee et al. (U.S. 6130726).

Referring to claim 20 Ellis teaches a remote wireless device (Figure 5 and Figure 2c element 24), comprising:

- (a) a display (Figure 5 element 52 and ¶[0059]);
- (b) an input device used to generate a message (Figure 5 element 52 and ¶[0059] and ¶[0107] teaches a message being generated; ¶[0074]); and
- (c) an application running on the wireless device (¶[0107] teaches generating a message on a wireless device so an application/software has to exist; ¶[0074]), and

emulates on the display control buttons (¶[0059] teaches the wireless display control device interface 52 being a system that can include a LCD, touch screen, and keyboard which creates a display with emulated control buttons);

(d) wherein the wireless device is used to control the selection of program channels displayed on a television that is in communication with a local device (¶[0106] teaches local device element 22 in Figure 2c);

(e) wherein the application uses at least a portion of electronic program guide (EPG) data received from the local device to provide an EPG menu on the display of the remote wireless device (¶[0041] teaches user television equipment 22 which includes a set-top-box forwarding program guide data to program guide access device 24 which is the remote display device; ¶[0080] and Figure 7 teach the program guide data being displayed on any suitable display device and ¶[0059] and Figure 3 teach the remote display device have a LCD display element 52).

Ellis fails to teach wherein the application presents on the display a plurality of selectable message destinations and a plurality of selectable message formats and displays a plurality of control buttons used to select (i) at least one of the destinations to which the generated message is to be sent, and (ii) at least one of the formats which define how the generated message is to be presented at the selected destinations; using the control buttons to navigate the EPG menu and make program channel selections displayed on the television without displaying the EPG menu on the television.

In an analogous art Tyson teaches wherein the application presents on the display a plurality of selectable message destinations (Page 181 “To Do: Addressing Your Message” and Figure 8.7 teach clicking the To button to select from a list the email address that you want to send you email to in the email program Microsoft Outlook) and a plurality of selectable message formats (Page 91 2rd paragraph “Back so soon?....” and Figure 4.15 teach being able to adjust the font using buttons in Figure 4.15) and displaying a plurality of control buttons used to select (i) at least one of the destinations to which the generated message is to be sent (Page 181 Figure 8.7 teaches a buttons which are displayed on the screen), and (ii) at least one of the formats which define how the generated message is to be presented at the selected destinations (Page 91 and Figure 4.15 teaches buttons that would be displayed on a screen that control the font of the email text).

At the time the invention was made it would have been obvious for one skilled in the art to modify the remote display device with a touch screen and email device of Ellis using the buttons on a display to control the destinations and format of the email device of Tyson for the purpose of adding destinations to the email more convenient.

Ellis and Tyson fail to teach using the control buttons to navigate the EPG menu and make program channel selections displayed on the television without displaying the EPG menu on the television

In an analogous art Darbee teaches using the control buttons to navigate the EPG menu and make program channel selections displayed on the television without

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displaying the EPG menu on the television (Column 2 lines 46-50 and Column 11 lines 6-11).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined methods of Ellis and Tyson using the EPG only displayed on the remote display device of Darbee for the purpose of preventing an interruption of content on a television (Column 2 lines 46-50, Darbee).

Referring to claim 22, depending on claim 20, Ellis teaches wherein the selectable message destinations include at the local device, the television ([0107] teaches a message being sent from remote access program guide which resides on remote display device element 24 to local interactive program guide which resides in element 22 in Figure 2c; the user television equipment element 22 then displays the message; Thus there must be a selectable destination on remote display device 24 for local interactive program guide which is a television; Figure 3 teaches element 22 includes a television element 36).

Referring to claim 25, depending on claim 20, Ellis teaches the method wherein the local device is one of a set-top box (STB), ([0047]), and a modem (Figure 3 teaches element 22 which includes element 28 a set-top box and inside element 28 is element 37 a modem, [0053]).

Referring to claim 26, depending on claim 20, Ellis teaches wherein the input device generates text messages and stores audible messages (¶[0141] and ¶[0142] teach being able to generate and store a audio message and being able to input a text message and the message can be transferred from the remote access program guide which is on element 24 in figure 2c to the local interactive program guide which is on element 22 in Figure 2c).

Referring to claim 27, depending on claim 26, Ellis teaches the remote wireless device of claim 26, further comprising:

(f) at least one speaker (¶[0059]); and

(g) a receiver that receives a text message generated by a user of a local device, wherein received text messages are presented on the display of the remote wireless device (¶[0107] teaches messages can be text messages and a local interactive television program guide can send a message to a remote program access device 24 which is the remote control).

Referring to claim 29, depending on claim 20, Tyson additionally teaches the method further comprising: (f) the user entering information into the remote wireless device to schedule when the generated message is to be sent (Page 187 Figure 8.12 teaches the "Do not deliver before:" drop down box in the Message Options window (Fourth box up from the bottom of the screen and see attached screen shot of the message options window). This allows a user to select a time for the message to be

sent and when time comes for the message to be sent the application sends the message to the destination).

At the time the invention was made it would have been obvious for one skilled in the art to modify the remote display device with a touch screen and email methods of Ellis using the buttons on a display to control the destinations and format of the email of Tyson for the purpose of making the messaging application more convenient for the user.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. 2006/0031883 A1) in view of Tyson (Sams Teach Yourself Microsoft Outlook 2000 in 24 Hours) further in view of Darbee et al. (U.S. 6130726) further in view of Kawana et al. (U.S. 2002/0023266 A1).

Referring to claim 23, depending on claim 22, Ellis, Tyson, and Darbee fail to teach the method wherein the wireless devices are connected to a wireless local area network (WLAN).

In an analogous art Kawana teaches the method wherein the wireless devices are connected to a wireless local area network (WLAN) (Figure 5 elements 200 and 240 and ¶[0038] teaches a home server and Bluetooth being used with a home server element 100).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined devices of Ellis, Tyson, and Darbee using the WLAN device of Kawana for the purpose of wirelessly controlling an apparatus that has the functions of recording and playing broadcast programs (¶[0009], Kawana).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. 2006/0031883 A1) in view of Tyson (Sams Teach Yourself Microsoft Outlook 2000 in 24 Hours) further in view of Darbee et al. (U.S. 6130726) further in view of Griffin et al. (U.S. 6489950 B1).

Referring to claim 28, Ellis, Tyson, and Darbee teach all the limitations of claim 20, but fail to teach wherein the application presents on the display a plurality of selectable predetermined messages, and the control buttons are used to select at least one of the predetermined messages to be sent to the selected destinations.

In an analogous art Griffin teaches wherein the application presents on the display a plurality of selectable predetermined messages, and the control buttons are used to select at least one of the predetermined messages to be sent to the selected destinations (Column 6 lines 2-7 teaches using buttons to select canned messages from a menu on a display).

At the time the invention was made it would have been obvious for one skilled in the art to modify the combined devices of Ellis, Tyson, and Darbee with the canned

responses method of Griffin for the purpose of being able to quickly respond to an email (Column 10 lines 64-67 and Column 11 line 1, Griffin).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

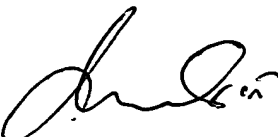
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PW



CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600